



Paper No. 5

COPY MAILED

SEP 14 2000

**SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS**

In re Application of
Anthony Puma, et al
Application No. 08/878,356
Filed: June 18, 1997
Attorney Docket No. None

DECISION GRANTING
PETITION

This is a decision on the petition filed January 14, 1998, requesting that the above-identified application be treated as a regular continuation-in-part application under 37 CFR 1.53. The Office apologizes for the delay in responding to this petition and any inconvenience caused applicants.

A review of the record discloses that on June 18, 1997, the application was deposited as a continuation-in-part application under 37 CFR 1.60¹. While the transmittal letter indicated a true copy of the prior application was being filed, no copy of the specification has been found. The filing included, inter alia, a preliminary amendment, 21 sheets of drawing, small entity declaration and a declaration under 37 CFR 1.63 signed by one of the three joint inventors.

Applicants are reminded that 37 CFR 1.60 clearly stated on June 18, 1997 that a continuation or divisional application for an invention disclosed in a prior nonprovisional application may be filed under this section provided applicant files, inter alia, "a true copy of the prior complete application as filed including the specification..." In this case, a continuation-in-part application is requested under 37 CFR 1.60 and the copy of the specification from the prior application is missing. The rule further states that the application will not be given a filing date earlier than the date upon which the copy is filed unless a petition with the requisite petition fee is filed which satisfactorily explains the delay in filing the missing items.

On November 14, 1997, Initial Patent Examination Division mailed a Notice of Improper Application filed under 37 CFR 1.60 which included a handwritten notation which read "under 37 CFR 1.60 you cannot file a Cont. In Part. You must submit a petition to convert."

¹37 CFR \$1.62 and \$1.60 were deleted from title 37 of the Code of Federal Regulation effective December 1, 1997. See Notice of Final Rule, 62 Fed. Reg. 53132 (October 10, 1997).

In response, on January 14, 1998, the present petition was filed. Petitioners indicate that the application was inadvertently filed under 37 CFR 1.60. Petitioners request, in effect, that the PTO disregard the 37 CFR 1.60 request and treat the application as a regular CIP application under 37 CFR 1.53.

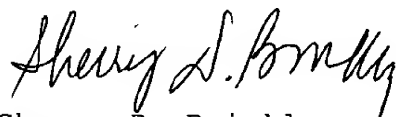
Absent a complete specification, the relief applicants seek is inconsistent with 37 CFR 1.53. However, as the PTO notice mailed November 14, 1997, did not clearly note that under the circumstances of this case, applicants must submit a petition to convert **the application to an application under 37 CFR 1.62**, the present petition is being construed as a request therefor.

The petition as construed is granted. The application will be treated as a continuation-in-part application under 37 CFR 1.62.

As the record has shown, an executed oath or declaration in compliance with 37 CFR 1.63 is required in this application. Accordingly, applicants are given ONE MONTH from the date of this decision to file an oath or declaration complying with 37 CFR 1.63 and to pay the \$130.00 surcharge set forth in 37 CFR 1.16(e). This time period may be extended pursuant to 37 CFR 1.136(a). The oath or declaration should identify the specification to which it is directed by reference to the above application number and filing date. The response should be directed to the attention of Initial Patent Examination Division. Failure to respond will result in the abandonment of this application.

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being returned to Initial Patent Examining Division to await the response required herein and then for reprocessing with a filing date of June 18, 1997, as a continuation-in-part application under 37 CFR 1.62, not an application under 37 CFR 1.60 of prior application No. 08/664,406.



Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy